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26646	7590	06/20/2007	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			CHEN, SHIN HON	
			ART UNIT	PAPER NUMBER
			2131	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/750,423	RICK, RALF	
	Examiner	Art Unit	
	Shin-Hon Chen	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 March 2007.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-15 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 28 December 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/11/07</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

1. Claims 1-15 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 5 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson et al. U.S. Pat. No. 6226747 (hereinafter Larsson) in view of Comerford et al. U.S. Pat. No. 5109413 (hereinafter Comerford).

4. As per claims 1, Larsson discloses a device for preventing pirated copies of computer programs for use with a computer (Larsson: column 3 line 42 – column 4 line 38), comprising: input and output device for bi-directional data exchange with the computer (Larsson: column 3 line 42 – column 4 line 38); a first memory element containing a data file that is transferable to the computer via the output device, the data file including a key uniquely identifying a licensed copy of the computer program (Larsson: column 5 lines 4-8 and column 8 lines 20-31: compare the identification information/verification key stored in the floppy disk with information stored on CD); and a second memory element into which data is writable by the input device, the data including an identifier uniquely identifying the computer (Larsson: column 9 lines 19-35: records

computer identification information); wherein the first memory and second memory element are arranged on a memory (memory chip, floppies, storage devices) (Larsson: column 5 lines 23-47). Larsson discloses that dongle is well known in the art to prevent unauthorized execution of software and the dongle is used to provide software key so that the software can be executed (Larsson: column 2 lines 11-39: dongle or hardware key). Larsson does not explicitly disclose wherein the device is configured to erase the key from the first memory element upon a successful transfer of the data file so that a subsequent attempt to transfer the data file to another computer does not result in a transfer of the key to the other computer unless the key has been transferred back to the device from the computer which received the key. However, Comerford discloses transferring the right to execute from one coprocessor to another (Comerford: column 7 lines 26-50: erase the software key and the movement of the rights between coprocessors and source device; column 17 lines 31-57: the coprocessor and the key stored within the coprocessor; figure 1 item 20). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use the coprocessor as the dongle because the coprocessor and the dongle are used to prevent unauthorized software execution. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Comerford within the system of Larsson because it reduces the opportunity for improperly multiplying rights to execute.

5. As per claim 4, Larsson as modified discloses the device according to claim 1. Larsson further discloses wherein the input and output devices are adapted to a module port of the computer so that the input and output devices are insertable into the module port (Larsson:

column 3 line 42 – column 4 line 37: inserting the floppy disk). Floppy disk provides input/output function and uses input/output port of a computer to read/write data to a computer.

6. As per claim 5, Larsson as modified discloses a method of preventing pirated copies of computer programs (Larsson: column 3 line 42 – column 4 line 38), comprising the steps of: connecting a device to a computer for bi-directional data exchange (Larsson: column 3 line 42 – column 4 line 38), the device including input and output devices and first and second memory elements (Larsson: column 5 lines 4-8 and column 8 lines 20-31: reading license information for verification; column 9 lines 19-34: writing computer identification information to memory); transferring a first data file containing a key from the first memory element of the device to the computer (Larsson: column 8 lines 20-49); and copying a second data file containing an identifier from the computer to the second memory element of the device (Larsson: column 9 lines 19-33).

7. As per claim 8, Larsson as modified discloses a data carrier storing a computer program (Larsson: column 3 line 42 – column 4 line 38), the computer program being executable by entering the data carrier into a computer (Larsson: column 3 line 42 – column 4 line 38), the data carrier containing a key and an identifier (Larsson: column 8 lines 20-49 and column 9 lines 5-33), the computer program, upon execution, carrying out the following steps: transferring a first data file containing the key from a first memory element of a device to the computer (Larsson: column 5 lines 4-8 and column 8 lines 20-49), the device further including input and output devices (Larsson: column 8 lines 20-49 and column 9 lines 5-33); and copying a second data file

containing the identifier from the computer to a second memory element of the device (Larsson: column 9 lines 5-33).

8. As per claim 9, Larsson as modified discloses the device of claim 1. Larsson further discloses the key includes an electronic key (Larsson: column 8 lines 20-31: electronic data including serial number and identifiers).

9. As per claim 10, Larsson as modified discloses the device of claim 1. Larsson further discloses the data file is transferable to the computer so that the data file is stored on the computer (Larsson: column 3 lines 53-62).

10. As per claim 11 and 12, Larsson as modified discloses the device of claim 1. Larsson further discloses the data file is transferable to the computer so that the data file is removed from the device and stored in the computer (Comerford: column 7 lines 26-41: erase the software key; column 17 lines 31-57: the coprocessor and the key stored within the coprocessor; figure 1 item 20). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use the coprocessor as the dongle because the coprocessor and the dongle are used to prevent unauthorized software execution. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Comerford within the system of Larsson because it reduces the opportunity for improperly multiplying rights to execute.

11. As per claim 13, Larson discloses a method of preventing a pirated copy of a computer program, comprising: determining whether a dongle is connected to a computer; checking whether the dongle contains a correct computer identifier when the dongle is connected to the computer (Larsson: column 3 line 42 – column 4 line 38); copying a key to the dongle when the dongle contains the correct computer identifier (Larsson: column 3 line 42 – column 4 line 38); and erasing the computer identifier in the dongle (Larsson: column 11 lines 19-29). Larsson does not explicitly disclose erasing the key in the computer. However, Comerford discloses transferring the right to execute from one coprocessor to another (Comerford: column 7 lines 26-41: erase the software key; column 17 lines 31-57: the coprocessor and the key stored within the coprocessor; figure 1 item 20). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to use the coprocessor as the dongle because the coprocessor and the dongle are used to prevent unauthorized software execution. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Comerford within the system of Larsson because it reduces the opportunity for improperly multiplying rights to execute.

12. As per claim 14, Larson as modified discloses the method of claim 13. Larsson as modified further discloses the method comprising: checking whether the key is valid; and copying a license number of a computer program to the dongle (Larsson: column 5 lines 4-22).

13. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view Comerford and further in view of Pavlin et al. U.S. Pat. No. 6523119 (hereinafter Pavlin).

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14. As per claim 2, Larsson as modified discloses the device according to claim 1. Larsson as modified does not explicitly disclose wherein memory chip includes a ROM memory chip. However, Pavlin discloses dongle/hardware key includes memory chip (Pavlin: column 4 line 66 – column 5 line 15). It is well known in the art to include memory chips in dongle/hardware keys which are used to protect software from illicitly used. Pavlin reference discloses read only memory chips such as EEPROM. However, it would have been obvious to one having ordinary skill in the art to change the memory chip disclosed by Pavlin to read/write memory chip to allow dynamic read/write function as supported by floppy disks and the floppy disk information disclosed by Larsson is stored in read-only area while the computer identification information is to be inputted into writable area of a memory chip because different memory devices can be used to carry out the functions of dongles/license floppies. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Pavlin within the system of Larsson because it is well known in the art to use different types of memory to perform security processes and it does not reduce the performance of the system. Alternatively, Larsson also discloses that other types of memory can be implemented (Larsson: column 5 lines 23-28).

15. As per claim 3, Larsson as modified discloses the device according to claim 2. Larsson as modified further discloses wherein the memory chip is a nonvolatile semiconductor memory (Pavlin: column 4 line 66 – column 5 line 15). Same rationale applies here as above in rejecting claim 2.

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16. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view of Comerford and further in view of Kupka U.S. Pat. No.6434535 (hereinafter Kupka) and further in view of Mullor et al. U.S. Pat. No. 6411941 (hereinafter Mullor).

17. As per claim 6, Larsson as modified discloses the method according to claim 5. Larsson does not explicitly disclose the method further comprising the step of entering into the computer an enable number encoded with the key. However, Kupka further discloses entering license information into the computer for verification (Kupka: column 1 lines 35-57). It would have been obvious to one having ordinary skill in the art to prompt users to enter license information for comparison is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kupka within the system of Larsson. Larsson as modified does not explicitly disclose entering encoded enable number encoded by key stored in the memory. However, Mullor discloses comparing decrypted license information stored in the computer (Mullor column 6 lines 28-39). It would have been obvious to one having ordinary skill in the art to modify the Larsson reference to store key for decrypting encrypted license information, which is well known in the art, and modify the Kupka reference by entering encrypted license information that can be decrypted using the key provided in the memory and then compare the result. Therefore, it would have been an obvious matter of design choice to modify the references to enter encrypted license information into computer and decrypt it using key stored in memory device since the applicant does not explicitly disclose entering encrypted license information and then decrypt it using key stored in the memory solves any stated problem or is for any particular purpose and it appears that comparing license information stored in the

memory with the license information stored in the software would perform equally well for verification.

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson.

19. As per claim 7, Larsson as modified discloses the method according to claim 5. Larsson does not explicitly disclose the step of transferring the key from the computer back to the connected device after checking the identifier. However, Larsson discloses uninstalling/removing the software from the computer in order to install on another computer and removing the computer identification from the file (Larsson: column 10 line 36 – column 11 lines 29). It would have been an obvious matter of design choice to modify the Larsson reference to transfer the key back from the computer back to the connected device after checking the identifier since the applicant does not disclose transferring the key back solves any stated problem or is for any particular purpose and it appears that uninstalling the software from the computer would perform equally well.

20. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larsson in view of Comerford and further in view of Kupka and further in view of Mullor.

21. As per claim 15, Larsson as modified discloses the method of claim 14. Larsson as modified does not explicitly disclose the method further comprising the step of entering into the computer an enable number encoded with the key. However, Kupka further discloses entering

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license information into the computer for verification (Kupka: column 1 lines 35-57). It would have been obvious to one having ordinary skill in the art to prompt users to enter license information for comparison is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kupka within the system of Larsson. Larsson as modified does not explicitly disclose entering encoded enable number encoded by key stored in the memory. However, Mullor discloses comparing decrypted license information stored in the computer (Mullor column 6 lines 28-39). It would have been obvious to one having ordinary skill in the art to modify the Larsson reference to store key for decrypting encrypted license information, which is well known in the art, and modify the Kupka reference by entering encrypted license information that can be decrypted using the key provided in the memory and then compare the result. Therefore, it would have been an obvious matter of design choice to modify the references to enter encrypted license information into computer and decrypt it using key stored in memory device since the applicant does not explicitly disclose entering encrypted license information and then decrypt it using key stored in the memory solves any stated problem or is for any particular purpose and it appears that comparing license information stored in the memory with the license information stored in the software would perform equally well for verification.

Response to Arguments

22. Applicant's arguments filed on 3/23/07 have been fully considered but they are not persuasive.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Larson reference discloses the access control to software is provided by comparing identification information stored onto the floppy disk with computer system identification (Larsson: column 3 lines 42-65. While Larsson discloses transfer of rights by writing and deleting identification information to/from the floppy disk, Larsson does not disclose transfer of key information from the floppy disk to/from computer system. However, Comerford reference is relied upon for another transfer of rights technique by transferring rights to execute in portable form from one computer system to another (Comerford: column 4 lines 42-50 and column 7 lines 26-50). Therefore, the reason to combine Larsson and Comerford reference is that both discloses transfer of rights method and the floppy disk disclosed by Larsson would allow the key to be stored and transferred from/to computer systems intended to receive the key so that upon the transfer of key, identification information of the computer system is written into the memory of floppy disk to track the system that currently holds rights to access.

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Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

SC



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100